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|---------------------------------------|---|----------------------|
| In re Application of | : | |
| SINCLAIR et al | : | DECISION ON |
| Application No.: 10/539,655 | : | |
| PCT No.: PCT/AU03/01691 | : | PETITION |
| Int. Filing Date: 18 December 2003 | : | |
| Priority Date: 18 December 2002 | : | UNDER 37 CFR 1.47(a) |
| Attorney's Docket No.: 123-003 | : | |
| For: AN ELONGATE ELECTRICAL CONDUCTOR | : | |
| THAT IS ADAPTED FOR ELECTRICALLY | : | |
| CONNECTING WITH AN ELECTRICAL CONTACT | : | |

This is in response to the petition under 37 CFR 1.47(a), filed 14 July 2008, to permit the applicant to file the above-captioned application on behalf of the non-signing inventor John Sinclair. The petition under 37 CFR 1.47(a) is DISMISSED.

BACKGROUND

On 18 December 2003, applicant filed international application PCT/AU03/01691, which claimed priority of an earlier Australian patent application, filed 18 December 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 01 July 2004. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 20 June 2005 (18 June 2006 was a Saturday).

On 14 June 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; a preliminary amendment; and an unsigned declaration. The declaration under PCT Rule 4.17 accompanied the international application and was signed by three of the four inventors.

On 13 May 2007, the United States Designated/Elected Office mailed a Notice of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) indicating that an oath or declaration had been filed on 14 June 2005.

On 14 July 2008 applicant filed the present petition accompanied by the required petition fee, a petition and fee for a three-month extension of time, the surcharge for submitting a late declaration, a declaration executed by Mr. Ward, a statement of Mr. Sinclair last know address.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. A review of the papers reveals that applicant has satisfied items (1), (3) and (4).

The evidence submitted to show Mr. Sinclair has refused to sign is insufficient. The declaration by Matthew Ward fails to indicate that a complete copy of the application was sent to the applicant. Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. Copies of documentary evidence such as a certified mail return receipt, cover letter of instructions, telegrams, etc., which support a finding that a complete copy of the application papers had been sent to the applicant should be made a part of the declaration or affidavit.

Furthermore, there e-mails correspondence between the non-signing inventor Mr. Sinclair and Matthew Ward fails to show a clear refusal to sign. It would appear that the e-mail of 9 July 2008 at 10:23 is not present and that the remaining e-mails do not clearly set forth a refusal.

CONCLUSION

The petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

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